

**REMARKS**

Claims 1, 3-7, 9-12, 14-18 and 20-29 are pending in this application. By this Amendment, claims 1, 6, 12, 18 and 26 are amended.

The courtesies extended to Applicant's representative by Examiner Wallerson at the interview held February 23, 2005, are appreciated. The reasons presented at the interview as warranting favorable action are incorporated into the remarks below and constitute Applicants' record of the interview.

The Office Action rejects claims 1, 6, 26 and 27 under 35 U.S.C. §102(e) over U.S. Patent No. 6,012,083 to Savitzky et al. ("Savitzky"). The rejection is respectfully traversed.

Independent claim 1 recites, *inter alia*, a method for submitting a document in electronic form from a computer to a service bureau for printing, comprising printing at the service bureau a document stored in memory accessible to the computer, wherein the computer's accessibility to the document does not require communication between the computer and the service bureau or the intermediary." Furthermore, the method comprises "transmitting the document from the computer to a server associated with the service bureau or an intermediary". Savitzky does not disclose, teach or suggest these features.

Savitzky only discloses, in Figs. 3-4 and at col. 11-13, a Web agency interposed between a Web client and a Web server, wherein documents are retrieved by the Web agency on order from the Web client. The only reference made by Savitzky to a method for printing is disclosed in Fig. 5 and at col. 12, lines 42-col. 13, lines 63, in which a printer agency 60, interposed between the client's browser 64 and the document 66, operates to respond to document print requests by the web client. As shown in Fig. 5, it would be impossible, in the apparatus of Savitzky, for the Web client to access a document stored in memory without first accessing the Web agency. Furthermore, unlike claim 1, the Web agency, shown in Fig. 5, receives the document directly from the memory device on which the document is stored.

Therefore, Savitzky fails to disclose, teach or suggest at least two features of claim 1: a document stored in memory accessible to the computer, wherein the "computer's accessibility to the document does not require communication between the computer and the service bureau or the intermediary;" and transmitting the document from the computer to a server associated with the service bureau or an intermediary." Accordingly, since Savitzky does not disclose, teach or suggest each and every limitation recited in claim 1, the rejection of claim 1 under 35 U.S.C. §102(e) is improper. Withdrawal of the rejection over Savitzky is respectfully requested.

Regarding claim 6, the Office Action asserts that Savitzky discloses, at col. 12, lines 58- col. 13 lines 10-14, receiving the print command from within an active application operating on the document to be printed. Notwithstanding the Office Action's assertion, Applicants respectfully submit that Savitzky fails to disclose an active application operating on the document prior to receiving the print command. Because Savitzky routes the document to the client through the agency only after the client has initiated a document request, it would be impossible to have an active application operating on the document prior to the print request, as recited in claim 6. Accordingly, claim 6 is likewise patentable over Savitzky, at least for its dependence on an allowable base claim, as well as for additional features it recites. Withdrawal of the rejection of claim 6 is respectfully requested.

Independent claim 26 is directed to a storage medium related to the method of claim 1 and is likewise patentable for the arguments presented above regarding claim 1, as discussed above. Claim 27 depends from independent claim 26 and is likewise patentable over Savitzky at least for its dependence on an allowable base claim, as well as for additional features it recite. Withdrawal of the rejection of claims 26-27 is respectfully requested.

The Office Action rejects claims 3, 5, 7 and 10 under 35 U.S.C. §103(a) over Savitzky in view of U.S. Patent Publication No. US 2003/0011806 A1 to Shiohara and U.S. Patent No.

6,134,568 to Tonkin; rejects claim 4 under 35 U.S.C. §103(a) as being unpatentable over Savitzky in view of Shiohara, Tonkin and U.S. Patent No. 6,012,070 to Cheng et al. ("Cheng"); rejects claim 9 under 35 U.S.C. §103(a) as being unpatentable over Savitzky in view of Cheng; rejects claim 11 under 35 U.S.C. §103(a) as being unpatentable over Savitzky in view of U.S. Patent No. 5,524,085 to Bellucco et al. ("Bellucco"); and rejects claims 23 and 29 under as being unpatentable over Savitzky in view of Shiohara. The Office Action asserts that Savitzky discloses all the features of claims 3-5, 7, 9-11, 23 and 29 except for deficiencies, which are allegedly cured by Shiohara, Tonkin, Cheng or Bellucco.

As discussed above, Savitzky fails to disclose, teach or suggest all the features recited in independent claims 1 and 26 from which claims 3-5, 7, 9-11, 23 and 29 depend. Similarly, neither Shiohara, Tonkin, Cheng nor Bellucco disclose, teach or suggest a method for submitting a document to a service bureau for printing, comprising a computer and a document memory, whereby the document is accessible to the computer without having a service bureau interposed between the memory and the service bureau, as recited in claims 1 and 26. Furthermore, Shiohara, Tonkin, Cheng and Bellucco fail to disclose a computer transmitting a document from the computer to the agency as recited in claims 1 and 26. Thus, the combination of the applied art fails under 35 U.S.C. §103(a) to disclose all the features recited in claim 1.

Accordingly, withdrawal of the rejections of claims 3-5, 7, 9-11, 23 and 29 are respectfully requested.

The Office Action further rejects claims 12, 15-18, 21, 22, 24 and 25 under 35 U.S.C. §103(a) as being unpatentable over Tonkin in view of Shiohara and further in view of Savitzky; and rejects claims 14 and 20 under 35 U.S.C. §103(a) as being unpatentable over Tonkin in view of Shiohara and Savitzky, and further in view of Bellucco. The Office Action asserts that Tonkin discloses all the features of claims 12, 14-18, 20-22, 24 and 25 except for

deficiencies, which are allegedly cured by one or more of Shiohara, Savitzky and Bellucco.

The rejections are respectfully traversed.

Similar to independent claims 1 and 26, independent claims 12 and 18, recite *inter alia*, a computer having a module stored thereon "to transmit a document to be printed from the computer to the server." As discussed above, nowhere does the combined disclosure of Tonkin, Shiohara, Savitzky and Bellucco disclose or suggest transmitting a document from a computer to a service bureau server as recited in claims 12 and 18.

Claims 15-17, 21, 22, 24 and 25 depend from independent claims 12 and 18 and are likewise patentable over the applied art for at least their dependence on an allowable base claim, as well as for additional features they recite. Accordingly, withdrawal of these rejections is respectfully requested.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1, 3-7, 9-12, 14-18 and 20-29 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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